

### **REMARKS**

The Office Action of **June 19, 2002** has been received and its contents carefully noted. Applicant respectfully submits that this response is timely filed and fully responsive to the Office Action. Claims 1-12 are pending the present application and are believed to be in condition for allowance for the reasons stated below.

#### **35 U.S.C. 103 Rejection**

Claims 1-12 stand rejected under 35 U.S.C. §103(a) as unpatentable over FIGs. 14-18 of the alleged Acknowledged Prior Art (Hereinafter "APA") in view of U.S. Patent No. 6,310,374 to Satoh et al. (Hereinafter "Satoh"). Applicant respectfully traverses this rejection for at least the following reasons.

##### **1. Summary of the Invention**

The claimed invention is directed generally to a semiconductor device with a high breakdown voltage comprising a semiconductor substrate of a first conductivity type, a drain region of a second conductivity type, a metal electrode electrically connected to the drain region, and an interlevel dielectric film formed over a gate insulating film, a field insulating film and a plurality of plate electrodes. In accordance with claims 1-12, parts of the metal electrode are (1) extended onto an interlevel dielectric film and (2) located over the plate electrodes.

##### **2. Lack of Motivation to Combine the Cited References**

Applicant respectfully contends that the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the proposed combination of the alleged APA with Satoh is

improper for a lack of motivation to combine their respective teachings in a manner that would render the claimed subject matter obvious. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of their combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. §2143.01 (2001).

In the present situation, the alleged APA relates to a semiconductor device with a high breakdown voltage, while Satoh is directed to a nonvolatile semiconductor memory device. In other words, the alleged APA and Satoh are directed to totally incompatible semiconductor devices. Hence, no motivation exists for combining the aforementioned references insofar as they each relate to different semiconductor devices. Therefore, one having ordinary skill in the art would not look to Satoh when seeking to modify the alleged APA.

### **3. The Combination of References Fails to Disclose the Claimed Invention**

Notwithstanding the aforementioned remarks, it is further contended that the proposed combination of references fail to disclose the claimed invention. Notably, the Examiner's characterization of the alleged APA is inaccurate.

For instance, the claimed subject matter recited in claim 1 requires that parts of the metal electrode (i.e., the metal electrode that is electrically connected to the drain in region) are (1) extended onto the interlevel dielectric film and (2) located over the plate electrodes.

On the other hand, as shown in Prior Art Fig. 14 of the subject application, the metal electrode (15) that is electrically connected to the drain region (1) is not connected to the floating metal electrodes (16, 17), (2) a part of the metal electrode (15) merely extends vertically, (3) is

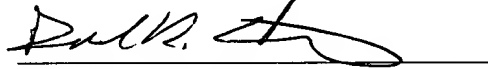
not extended onto the interval dielectric film and (4) also not located over the plate electrodes. Hence, several defects exists in the alleged APA that, when combined with Satoh, would fail to render the claimed invention obvious.

Further, the Examiner also misunderstands the teachings of Satoh. In accordance with Satoh, the floating gate (14) is in the nonvolatile semiconductor memory device is merely capacitively coupled with the control gate (16). Satoh fails to disclose that each part of the metal electrode is capacitively coupled to an associated one of the plate electrode formed on the field insulating film. Insofar as the primary reference (the alleged APA) and the secondary reference (Satoh) of the proposed combination both contain defects, a case of *prima facie* obviousness cannot be supported. Reconsideration and withdrawal of the rejection is respectfully solicited.

**Conclusion**

Accordingly, Applicant respectfully contends that the claimed invention defines subject matter that is clearly patentably distinct over the prior art of record. It is respectfully requested that the rejection be withdrawn. If the Examiner believes further discussions with Applicants' representative would be beneficial in this case, he is invited to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Donald R. Studebaker", is written over a horizontal line.

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